

### REMARKS

This application has been reviewed in light of the Office Action dated November 21, 2003. Claims 1-11, 19-30, 32-40, and 48-56 are presented for examination, of which Claims 1, 19, 25, 32, 33, and 48 are in independent form. Claims 12-18, 31, and 41-47 have been cancelled, without prejudice or disclaimer of the subject matter presented therein. Claims 1, 3, 5, 19, 23-28, 32-34, 36, 38, 48, 49, 51-55 have been amended as to formal matters, and not to overcome any of the prior-art rejections discussed below. Favorable reconsideration is requested.

As requested in section 1 of the Office Action, attached is a courtesy copy of the Information Disclosure Statement (IDS) filed on August 31, 2000. This IDS cites only a co-pending application and therefore does not include a PTO-1449 form.

Applicants affirm the election of Claims 1-11, 19-30, 32-40, and 48-56 for prosecution in the present application. As indicated above, the non-elected claims have been canceled.

The Office Action states that Claims 5, 28, and 38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. These claims have been amended to reflect the Examiner's suggested changes. Accordingly, withdrawal of the rejections is respectfully requested.

The Office Action states that Claims 1-11, 19-30, 32-40, and 48-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,567,800 (Barrera) in view of excerpts from the book "Using Netscape" (Ernst), published in 1995 by Que Corp. Applicants

respectfully traverse the rejections and submit that independent Claims 1, 19, 25, 32, 33, and 48, together with the claims dependent therefrom, are patentably distinct from the cited prior art for at least the following reasons.

An aspect of the present invention set forth in Claim 1 is directed to a method of presenting search results obtained from a search conducted over a computer network. The search is performed using searching criteria and returns information including a plurality of network locations. According to this method, data from a first one of the network locations is extracted and examined to identify therein the searching criteria to provide at least one specific location within the data of the first network location of the searching criteria. The one specific location is used to identify specific data from the data. The specific data includes at least the searching criteria and is formatted into a printable document. The above steps are repeated for each remaining network location, and the formatted data of the remaining network locations is incorporated to the printable document.

An aspect of the present invention set forth in Claim 19 is directed to a method of formatting an electronic document intended for reproduction by printing. According to this method, a searching process obtains location information within a computer network of at least one search result returned by the searching process. The location information is used to fetch data from the computer network relating to each search result. The fetched data includes searching criteria used to instigate the searching process. The fetched data, including the searching criteria, is formatted into a printable electronic document.

Ernst relates to the Netscape browser and how to use it. Barrera relates to a

system for searching for information stored in web sites, in which category information is used to narrow search results.

As understood by Applicants, Barrera emphasizes the concept of a "context search." Such a "context" is depicted in the discussion of the Yahoo web pages shown in Figs. 1 and 2, and also in the discussion of Figs. 4 and 7-10. In this regard, the type of searching conducted according to Claims 1 and 19 is not express or explicit. As a consequence, the general issue of "context" is irrelevant to Claims 1 and 19 in relation to the raw search results, which are specific network locations that return a result in accordance with the search criteria. More specifically, in accordance with Claims 1 and 19, it is irrelevant what particular search operation is conducted, be it a search operation via Yahoo, AltaVista, or the arrangement disclosed in Barrera, because the claimed methods can operate with any of those as well as other search operations.

Nothing has been found in Barrera or in Ernst that is believed to disclose or suggest a method of presenting search results obtained from a search in the manner recited in Claims 1 and 19. Significantly, these claims are not concerned with *conducting* a search but rather with *presenting results* of a search. The general impetus of Barrera, however, as clearly stated in column 2, lines 44 to 52, is to yield more accurate search results by using the narrowing effect of category searching. This is emphasized in the flow chart of Fig. 6 of Barrera. Further, Figs. 1-4 of Barrera show various prior-art search engines in operation, and is understood to be provided purely for the purpose of illustrating different ways of categorizing searches and how search results are revealed in a category-search format. Again, Claims 1 and 19 are not

concerned with the actual search operation but instead is concerned with presenting the results of a search.

As acknowledged on page 5 of the Office Action, "Barrera does not specifically teach that the search terms themselves . . . are formatted (displayed) along with retrieved information, as claimed." Applicants concur. Significantly, as shown in Fig. 10 of Barrera, after searching the word "telephone," the search results are presented as four individual items, none of which is depicted as containing the search term "telephone." As a consequence, Fig. 10 of Barrera is believed to teach away from Claim 1, which recites, *inter alia*, "specific data including at least said searching criteria," and "formatting said specific data into a printable document." Similarly, Fig. 10 of Barrera is believed to teach away from Claim 19, which recites, *inter alia*, "said data including searching criteria used to instigate said searching process," and "formatting the fetched data including said searching criteria into a printable electronic document."

Having conceded on page 5 that the search results shown in Fig. 10 do not include the term "telephone," the Office Action then seeks to rely upon the disclosure of Fig. 4 of Barrera as providing an example of a case in which the search term appears in each item of the displayed search results. In this regard, Applicants acknowledge that Fig. 4 shows the search term "AT&T" as being represented in five of the six items illustrated, and further acknowledges that in many instances of searching the World Wide Web the search term forms part of the search result. However, as discussed in the introductory portion of the present application, in a good number of searches, using traditional search-engine presentation formats, the specific search term

is not presented in the results. As a consequence, a user may question the relevance of those search results.

Applicants note that, in relation to Fig. 4 of Barrera, which is described at column 2, lines 21 to 43, there is no express comment or statement made as to the desirability of presenting the search term "AT&T" in any item of the search results revealed by the Alta Vista search engine. Although, Barrera at column 2, lines 32-34, refers to "some excerpted content (e.g., 403) [being] displayed," there is no statement in Barrera that such content is displayed on the basis that it contains the search term "AT&T."

As a consequence, it is considered that the presentation in Fig. 4, in which some of the items returned in the search include the search term "AT&T," is nothing more than a fortuitous aberration that has been interpreted out of context. In fact, Applicants note that item 5 in the search results shown in Fig. 4 of Barrera does not include the express search term of "AT&T" but rather a variation thereof, "AT+T." Therefore, the search results shown in Fig. 4 of Barrera, are inconsistent with that of Claims 1 and 19.

Applicants respectfully submit that the failure to include the search term "telephone" in the search results of Fig. 10, and the incomplete inclusion of the search term "AT&T" in each item of the search results of Fig. 4, would provide a person of ordinary skill in the relevant art with no suggestion to present a search term with each item returned in the results of a search.

More specifically, Applicants submit that a combination of Barrera et al. and Ernst, assuming such combination would even be permissible, would fail to teach or suggest a

method of *presenting* search results obtained from a search conducted over a computer network, wherein the search is performed using searching criteria and returns information including a plurality of network locations, and wherein the method includes "extracting data from a first one of said network locations," and "examining said data to identify therein said searching criteria to provide at least one specific location within said data of said first network location of said searching criteria," and "using said one specific location to identify from said extracted data *specific data including at least said searching criteria*," and "*formatting said specific data into a printable document*," and "repeating steps (a) to (d) for each remaining said network location in which step (d) incorporates said formatted data of said remaining network location to said printable document," as recited in Claim 1 (emphasis added).

Further, Applicants submit that a combination of Barrera et al. and Ernst, considered individually or in combination, assuming a permissible combination even exists, would fail to teach or suggest a method of formatting an electronic document intended for reproduction by printing, wherein the method includes "obtaining from a searching process location information within a computer network of at least one search result returned by said searching process," and "using said location information to fetch data from said computer network relating to each said search result, *said data including searching criteria used to instigate said searching process*," and "*formatting the fetched data including said searching criteria into a printable electronic document*," as recited in Claim 19 (emphasis added).

Accordingly, Applicants submit that Claims 1 and 19 are patentable over the cited art and respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a).

Independent Claims 25, 32, 33, and 48 include features similar to those discussed above and therefore also are believed to be patentable for at least the above reasons.

The other rejected claims remaining in this application depend from one or another of the independent claims discussed above, and therefore are submitted to be patentable for at least the above reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

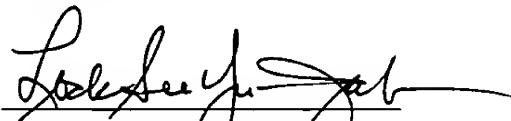
In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.



CONCLUSION

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

  
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